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Paper No. 5

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MAR 11 2003

OFFICE OF PETITIONS

In re Application of :
Michael Sprague, Eric Beckman and :
Michael Perhaes :
Application No. 10/036,329 :
Filed: October 19, 2001 :
Title: BROADCAST BROWSER INCLUDING :
MULTI-MEDIA TOOL OVERLAY AND METHOD :
OF PROVIDING A CONVERGED :
MULTI-MEDIA DISPLAY INCLUDING :
USER-ENHANCED DATA :

DECISION REFUSING STATUS
UNDER 37 C.F.R. § 1.47(a)

This is in response to the "Petition to Accept Oath and Declaration under 37 CFR 1.47," filed September 9, 2002 (certificate of mailing August 30, 2002).

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on October 19, 2001, with an unexecuted declaration, missing the statutory basic filing fee and with additional claim fees due. Eric Beckman, Michael Perhaes and Michael Sprague were named as joint inventors. Accordingly, on January 30, 2002, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring the missing items, including an executed oath or declaration and a surcharge for its late filing. In addition, the Notice stated that substitute drawings in compliance with § 1.84 were required¹. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

¹ Receipt of the substitute drawings filed September 9, 2002 is acknowledged.

In response, applicants filed a declaration executed by joint inventors Sprague and Beckman; the surcharge under § 1.16(e); and the instant petition under § 1.47(a). This response was made timely by an accompanying petition for extension of time within the fifth month. Applicants assert that status under § 1.47(a) is proper because inventor Perhaes refuses to join in the application. In support thereof, applicants submitted declarations of Simon Tidnam and Daniel J. Bourque, with copies of E-mail communications between Mr. Tidnam and inventor Perhaes.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirements (1) and (2).

As to requirement (1), petitioner has not shown that inventor Perhaes has refused to join in the application as required by § 1.47. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). Petitioners have not provided evidence that the application papers (specification, including claims, drawings, and oath or declaration) were all presented to inventor Perhaes for his signature.

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Perhaes and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Furthermore, a review of the E-mail communication purportedly showing inventor Perhaes' refusal to join in the application reveals a lack of reference to whether or not he was willing to sign the declaration. Inventor Perhaes refuses to sign an

assignment stating that "I'll sign the patent assignment, but not for a dollar." Neither of the declarations in support of the petition sets forth the circumstances of an oral refusal to join in the application by signing a declaration. As inventor Perhaes has not been presented with all of the application papers, his refusal to sign cannot be inferred from his conduct.

On renewed petition, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Thus, on renewed petition, a declaration of facts from such a person with firsthand knowledge is required.

As to requirement (2), applicants have submitted a declaration executed by joint inventors Sprague and Beckman. 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP \$602, \$605.01, and \$1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.

(Emphasis added).

Here, applicants have submitted a declaration for patent executed by inventors Sprague and Beckman. This declaration is numbered pp. 1 of 3, 2 of 3 and 3 of 3. Page 2 of 3 ends with a signature block for first named inventor Sprague. Page 3 of 3 begins with a signature block for second named inventor Beckman; the remainder of page 3 is blank. Following page 3 of 3 is a page 3 of 4 containing only the unexecuted signature block of inventor Perhaes. This page 3 of 4 is not clearly a part of the declaration numbered pages 1-3. Given the format (page numbering and spacing) of the declaration, it is unclear whether inventors Sprague and Beckman were presented with a declaration in compliance with §§ 1.63 and 1.64, naming all of the actual inventors. Accordingly, it is concluded that the declaration filed September 9, 2002 is not acceptable.

On renewed petition, applicants must correct the following deficiencies:

1. Provide adequate proof of presentation of all of the application papers to inventor Perhaes and of his subsequent refusal, consistent with the guidance set forth in MPEP 409.03(d)²;
2. Supply an acceptable oath or declaration properly executed by all available joint inventors on behalf of themselves and on behalf of non-signing inventor Perhaes (Rule 47 applicants are reminded that an oath or declaration with non-initialized/non-dated changes is unacceptable).

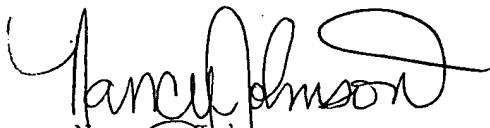
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
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By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
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Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0309.



Nancy Johnson
Petitions Attorney
Office of Petitions

² 8th ed. (Rev. Aug 1, 2001).